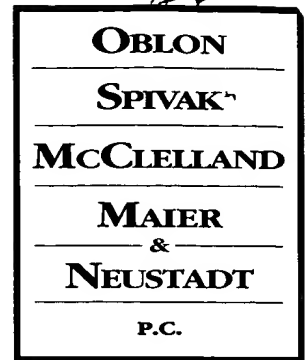




Docket No.: 0834-0275-3

COMMISSIONER FOR PATENTS  
ALEXANDRIA, VIRGINIA 22313



RE: Application Serial No.: 09/639,946  
Applicants: Hidehiko NAGAYA, et al.  
2<sup>nd</sup> RCE Filed: November 17, 2003  
For: THROWAWAY TIP AND THROWAWAY-TYPE  
CUTTING TOOL  
Group Art Unit: 2183  
Examiner: TSAI, H.

ATTORNEYS AT LAW

GREGORY J. MAIER  
(703) 413-3000  
GMAIER@OBLON.COM

CHRISTOPHER D. WARD  
SENIOR ASSOCIATE  
(703) 413-3000  
CWARD@OBLON.COM

SIR:

Attached hereto for filing are the following papers:

**PROVISIONAL ELECTION OF SPECIES**

Our check in the amount of \$0.00 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.

  
\_\_\_\_\_  
Gregory J. Maier

Registration No. 25,599

Customer Number

**22850**

(703) 413-3000 (phone)  
(703) 413-2220 (fax)

Christopher D. Ward  
Registration No. 41,367

0834-0275-3



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF: :  
Hidehiko NAGAYA, et al. : EXAMINER: TSAI, H.  
SERIAL NO.: 09/639,946 :  
2<sup>nd</sup> RCE FILED: November 17, 2003 : GROUP ART UNIT: 2183  
FOR: THROWAWAY TIP AND :  
THROWAWAY-TYPE  
CUTTING TOOL

PROVISIONAL ELECTION OF SPECIES

COMMISSIONER FOR PATENTS  
ALEXANDRIA, VA 22313-1450

SIR:

In response to the Election of Species requirement dated October 19, 2004, the Applicants provisionally elect with traverse the species of Group I corresponding to Claims 19, 22-25, 32-35, 37-40, 58-68, and 70-97 as readable on the provisionally elected species.

The Applicants respectfully traverse the election requirement for several reasons.

First, the outstanding Official Action merely includes the conclusory statement that "[t]his application contains claims directed to ... patentably distinct species ..." without stating any basis whatsoever in support of such a finding. This is in violation of MPEP §816, which states:

The particular reasons relied on by the examiner for holding the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given. ...

In the absence of any annunciated basis, it is respectfully submitted that the PTO clearly has not carried forward its burden of proof to establish distinctness.

Application Serial No.: 09/639,946  
Response to Election of Species Requirement  
dated October 19, 2004

Secondly, MPEP § 806.04(f) requires:

Claims to be restricted to different species must be mutually  
exclusive. ...

The outstanding Official Action fails to address in any way whether the pending claims recite mutually  
exclusive characteristics and this failure provides a further basis for traversing the election requirement.

Finally, MPEP § 803 states:

... If the search and examination of an entire application can be  
made without serious burden, the Examiner must examine it on the  
merits, even though it includes claims to distinct or independent  
inventions.

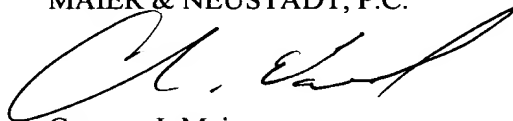
The claims of the present invention would appear to be part of an overlapping search area.

Accordingly, the Applicants also respectfully traverse the outstanding Election requirement on the  
grounds that a search and examination of the entire application would not place a *serious* burden on the  
Examiner.

Therefore, it is respectfully requested that the requirement to elect a single species be  
withdrawn, and that a full examination on the merits of Claims 19, 22-25, 32-35, 37-40, 58-68, and 70-  
99 be conducted.

Respectfully Submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.



Gregory J. Maier  
Registration No. 25,599  
Attorney of Record

Christopher D. Ward  
Registration No. 41,367

Customer Number

**22850**

Tel. (703) 413-3000  
Fax. (703) 413-2220  
(OSMMN 10/01)

GJM:CDW:brf

I:\atty\cdw\0834\0834 0275\Election of Species.doc